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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/855,020	05/15/2001	Mitsuhiro Idaka	Q64489	8003

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SUGHRUE MION ZINN MACPEAK & SEAS, PLLC
2100 Pennsylvania Avenue, NW
Washington, DC 20037-3213

EXAMINER

CAPRON, AARON J

ART UNIT	PAPER NUMBER
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3714

DATE MAILED: 12/20/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/855,020

Applicant(s)

IDAKA, MITSUHIRA

Examiner

Aaron J. Capron

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 October 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3-9,11 and 12 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3-9,11 and 12 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

MARK SAGER
PRIMARY EXAMINER

DETAILED ACTION

This is a response to the Amendment received on October 15, 2002, in which claims 1, 6 and 9 were amended and claims 2 and 10 were cancelled. Claims 1, 3-9 and 11-12 are pending.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 2 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sparks in view of Schneier et al. (U.S. Patent No. 6,099,408; hereafter "Schneier").

Sparks discloses a game machine that includes a player identifier (a player logs onto the website--Abstract), a data storage that stores personal information (5:9-14) of a plurality of players, and a game environment arranger that reads out the personal information of the player identified by the player identifier from the data storage and automatically sets up a game environment (6:6-21) based on the read out personal information, wherein the personal information includes parameters of play of the game. If there is no new information (user preferences), the game environment is automatically set up, as described in the text above. Sparks does not disclose the player identifier using image recognition techniques. However, Schneier discloses a biometric device that could incorporate the image recognition techniques (16:7-13) in order to add extra security features to the electronic game. The two references are

analogous since both references refer to needing a player identifier for playing an electronic video game and use player preferences to alter the game. One would be motivated to combine the two references in order to upgrade the security features of Sparks in order to ensure that the player playing the game is categorized into the player's respective skill level, especially for tournament play (Sparks 3:51-55). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to incorporate the biometric device into Sparks game machine because a biometric device would offer an upgrade to verify whether the authorized player is playing the game and the player's respective skill level.

Referring to claim 3, Sparks discloses a game monitor that monitors status of the game played by the player to generate monitoring information (1:60-65) and a personal information generator that generates new personal information of the player based on the monitoring information and stores the new personal information in the data storage (5:9-14 for example the preferred weapon).

Referring to claim 4, Sparks discloses an information communicator that communicates the personal information stored in the data storage with another game machine connected to the game machine (Figure 1).

Referring to claim 5, Sparks discloses a level determiner that automatically determines a skill level of the player to generate skill level information based on the monitoring information (Figure 11A; 6:49-61) where the personal information generator incorporates the skill level information to the personal information and where the game environment arranger automatically reads out personal information of another player stored in the data storage as an opponent in a multi-player game based on the skill level information of the player (Figure 11A; 6:62-7:3).

Sparks discloses at least one of the features listed in each of the claims below, but does not teach all of the features listed in each of the claims below. However, these “untaught” features are equivalent to the features that are disclosed by Sparks. Referring to claim 6, Sparks discloses the personal information includes at least one of information regarding a skill level of the player, information regarding the number of tokens acquired in the game, and information regarding growth status in a raising game (5:5-16 and 6:49 to 7:34).

Claims 7-8 and 11-12 correspond in scope to a system set forth for use of the machine listed in claims 1, 3-6 and are encompassed by use as set forth in the rejection above.

Referring to claim 9, Sparks discloses a network system that includes a host apparatus and the respective game machines are connected via the Internet to play a network game provided on the Internet (Abstract).

Response to Amendment

Applicant's arguments filed on October 15, 2002, have been fully considered, but the arguments are insufficient to overcome Sparks in view of Schneier.

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, as applicant argues, that there would be no motivation to combine the

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multiplayer game system implemented over the web of Sparks into the biometric device taught by Schneier. Sparks's game would not need such sophisticated hardware since the player's merely play the game for fun and not for prizes, such as money. However, Sparks discloses that the game could use another statistics program, such as ngTCS tournament control system in order to control the features of the game (3:51-55), which would allow the game to be played in tournament mode. Tournaments can have separate subdivisions based upon the skill level of the players and a prize associated with each subdivision. This type of handicapped tournament would ensure that every participating player would have a chance to win a prize. Some highly skilled players could try to give themselves a better chance of winning a prize by playing in a less skilled subdivision. In order to accommodate for this form of cheating, a biometric device would ensure that every player would have a chance to win based upon the player's handicapped skill level. Therefore, one of ordinary skill in the art would be motivated to combine Sparks in view of Schneier.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37

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CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.


The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

ngTCS from NetGames USA-Female Frag Fest 99 Finals Prizes discloses that the ngTCS control system is used for tournament play.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Aaron J. Capron whose telephone number is (703) 305-3520. The examiner can normally be reached on M-F 8-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tom Hughes can be reached on (703) 308-1806. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9302 for regular communications and (703) 872-9303 for After Final communications.

ajc
December 16, 2002



MARK SAGER
PRIMARY EXAMINER